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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/855,300
Filing Date: May 15, 2001
Appellant(s): WALKER ET AL.

Michael D. Downs
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 12, 2007 appealing from the Office action mailed June 30, 2006.

(1) Real Party in Interest

- A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

- The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

- The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

- The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

- The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claims 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

- The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- Carson et al ("College Accounting, Eighth Edition", South-Western Publishing Company, 1967, page 331)

(9) Grounds of Rejection

- The following ground(s) of rejection are applicable to the appealed claims:

- ***Claim Rejections - 35 USC § 101***

The amendment filed on April 10, 2006 failed to correct the 35 U.S.C. 101 deficiencies in Claims 1 – 37, detailed in the Office Action dated December 6, 2005. Therefore, the 35 U.S.C. 101 rejection in the Office Action dated December 6, 2005 is maintained.

(Copy of deficiencies in Claims 1-37 detailed in the Office Action dated December 6, 2005)

Claims 1-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to non-functional descriptive material, i.e. a printed document. Per MPEP 2106B1: Descriptive material can be characterized as either functional descriptive material or nonfunctional descriptive material. In this context, functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. Nonfunctional descriptive material includes but is not limited to music, literary works, and a compilation or mere arrangement of data. Both types of descriptive material are nonstatutory when claimed as descriptive material *per se*. *In re Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. The claimed billing statement is merely a document containing information, presumably about a monetary amount owed by the receiving party. Therefore, none of the claims include any functional language describing actions to be taken to nor procedures to be followed in order to produce the invention, and are thus considered to be nonfunctional descriptive material.

○ *Claim Rejections - 35 USC § 112*

The amendment filed on April 10, 2006 failed to correct the 35 U.S.C. 112 deficiencies in Claim 38 and Claim 39. While the amendment added additional steps the claims, the claims do not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to determine the step or steps needed to arrive at the invention commensurate in scope with the claims. Therefore, the 35 U.S.C. 112 rejection detailed in the Office Action dated December 6, 2005 is maintained.

(Copy of deficiencies in Claims 1-37 detailed in the Office Action dated December 6, 2005)

Claims 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for generating a billing statement, does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to determine the step or steps needed to arrive at the invention commensurate in scope with these claims. Claims 38 and 39 recite a single step of “generating a billing statement...”, thus, these two claims are single step process claims akin to the single means claims addressed in MPEP 2164.08(a). By definition, a process is the combination of two or more steps. “A single means claim, i.e. where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). (A single means claim which covered every conceivable means for achieving the state purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to *Hyatt* is

possible, where the claim covers every conceivable structure (means) for achieving the stated purpose (result) while the specification discloses at most only those known to the inventor.”

○ ***Claim Rejections - 35 USC § 102***

Claims 1, 2, 10-13, 20, 21, 23, 30, 31, 35-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Carson et al (“College Accounting, Eighth Edition).

Claims 1, 20, and 23: Carson discloses a billing statement comprising a description of a transaction and an offer pointer associated with the transaction, wherein the offer pointer comprising information for use to review an offer (page 331).

Claims 2 and 21: Carson discloses a billing statement as in Claims 1 and 20 and further discloses the billing statement is a printed document (page 331).

Claim 10: Carson discloses a billing statement as in Claim 1 above, and further discloses that the offer pointer is not an offer (page 331).

Claims 11, 12, 30, and 31: Carson discloses a billing statement as in Claims 1 and 20 above, and further discloses the billing statement describing a plurality of transactions and that the offer pointer is associated with one or more of the transactions (page 331).

Claim 13: Carson discloses a billing statement as in Claim 1 above, and further discloses that the offer is an offer to reduce the amount owed with the associated transaction (page 331).

Claims 35-37: Carson discloses a billing statement as in Claim 20 above, and further discloses that the amount owed is equal to the minimum payment (i.e. pay-in-full), equal to the cost of the transaction (i.e. pay-in-full), or equal to the total amount owed described in the billing statement (i.e. payment for all transactions)(page 331).

Claims 38 and 39: Carson discloses a method comprising generating a billing statement with a description of a transaction; and determining an offer pointer that can be used for review of an offer associated with the offer pointer (page 331).

Claims 40 and 41: Carson discloses a method comprising receiving transaction information, determining an offer/offer pointer based on the transaction information, and transmitting the offer pointer on a billing statement (page 331).

Claims 42 and 43: Carson discloses a method comprising receiving an offer pointer associated with a transaction on a billing statement, transmitting the offer to the customer, and determining a new amount owed by the customer if the offer is accepted (page 331).

○ ***Claim Rejections - 35 USC § 103***

Claims 3-9, 14-19, 22, 24-29, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al ("College Accounting, Eighth Edition).

Claims 3 and 22: Carson discloses a billing statement as in Claims 1 and 20 above, and further discloses the billing statement is a printed document. While it is not explicitly disclosed that the billing statement could also comprise viewable electronic data (i.e. electronic document), Official Notice is taken that it is old and well known to present billing and other financial information as viewable electronic data (i.e. computer displays). For example, for the past several decades customers have been able to access their financial data, to include statements, on electronic devices such as ATM machines. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the billing statement from viewable electronic data (i.e. an electronic billing statement). One would have been motivated to provide an electronic billing statement in order to allow remote access to the data without necessitating printing, collating, and mailing a hard copy of the information to the customer.

Claims 4-9 and 24-29: Carson discloses a billing statement as in Claims 1 and 23 above, but does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer. For example, Carson discloses an offer pointer (“See note below”) on line 8 of the billing statement which directs the customer to the offer (in the “AGENT PLEASE NOTE” section) printed on the bottom of the billing statement. If the offer consisted of a number of terms which would not have fit on the bottom of the page, the pointer would have directed the customer to the appropriate

location, such as “See page 2”, “Call (202) 111-1111 for terms of offer”, “Terms of offer available at 2021 Roosevelt Street, Alexandria, VA 20221”, “Terms of offer available at www.offer.com”, “Terms of offer may be requested via fax at (202) 111-1112”, etc., depending on the communicative abilities of the billing statement provider’s system. One would have been motivated to update the 1960’s billing statement of Carson to include more modern communication means, such as a telephone number or URL; in order to take advantage of the latest communication means available at the time of invention.

Claims 14-16: Carson discloses a billing statement as in Claim 1 above, and further discloses the terms of the offer is to reduce the amount owed for the transaction. While it is not explicitly disclosed that the terms of the offer is to reduce the interest rate, to extend the due date, or to eliminate the minimum amount due, these are all well known types of offer terms used by billers to entice customers to remit payments early, to use a particular form of remittance (electronic vs check), etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set the terms of the offer so as to eliminate the minimum amount due, extend the due date, or change the interest rate. One would have been motivated to set different terms for different offers in order to give the biller more latitude in selecting offers to present.

Claims 17 and 32: Carson discloses a billing statement as in Claims 1 and 20 above and further discloses the billing statement comprises a second description of a second transaction, but does not explicitly disclose a second offer pointer associated with the second transaction. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the same or different offer terms for

each of the transactions listed on Carson's billing statement. One would have been motivated to provide separate offers for separate transactions in order to allow the biller to "push" certain types of transactions. For example, a biller may give a straight 2% discount for all transactions paid within 7 days and may give an additional 2% discount for each transaction over \$100 to entice the purchaser to make higher value transactions.

Claims 18 and 33: Carson discloses a billing statement as in Claims 17 and 32 above, and further discloses the second offer is the same as the first offer (i.e. the same offer pertains to all of the transactions listed on the billing statement)(page 331).

Claim 19 and 34: Carson discloses a billing statement as in Claims 1 and 20 above, but does not disclose that the offer is located adjacent to the transaction description.

However, it is a design choice of the biller on where to place the various information and data on the billing statement page. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the offer adjacent to the transaction information to which the offer pertains. One would have been motivated to place it adjacent in order to allow the customer to quickly identify which offer pertained to which transaction (if the offers were not all the same).

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 40-42 fail to meet the above requirements.

(10) Response to Argument

- **35 USC § 101 Rejection of Claims 1-37**

- **Response to argument directed towards claims 1, 2, 4-19**

The applicant argues that the Examiner has inappropriately characterized the pending claims 1, 2, and 4-19 as being directed to “non-functional descriptive material, i.e. a printed document”. However, the applicant then makes the following admissions on Page 97, of the Appeal Brief:

“The billing statement may be a printed document, such as a credit card billing statement.”

“Therefore, the offer pointer could be, for example, a toll-free telephone number printed adjacent a description of a transaction on a credit card billing statement.”

The applicant further asserts that this arrangement of printed matter provides functionality in that a consumer may use the offer pointer to access complex details of offers that are provided elsewhere. However, the consumer that uses the phone number to contact the offer provider

is providing the functionality the applicant claims is provided by the printed matter itself. The phone number printed on the billing statement cannot in and of itself provide any functionality. As such, printed matter does not fall into a statutory class because it is not a "process, machine, manufacture, or composition of matter" as required by 35 USC 101. Additionally, the applicant asserts that the claims meet the proper legal test for the presence of statutory subject matter under the useful, concrete and tangible test. However, the useful, concrete and tangible test requires that a claimed process or apparatus "produce a useful, concrete and tangible result". The claimed printed matter is neither a process nor an apparatus and is incapable, in and by itself, of producing a result because it has no functionality. Any type of result achieved by the use of a phone number on a billing statement is produced by a customer who elects to utilize the contact method printed on the statement.

○ **Response to argument directed towards claim 3**

The appellants argue that claim 3 provides a useful concrete and tangible result because the Federal Circuit in *State St. Bank* found a useful, concrete and tangible result in the mere determining of "a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades". However, this only strengthens the Examiner point. The cited case law requires that a "determination" be made, and thus functionality has been introduced. The limitations of claim 3 merely require that the billing statement is presented in electronic form. This would incorporate such things as an email message containing the billing statement. As such no functionality is added to printed matter. It is now merely printed matter displayed in electronic form rather than on a piece of paper. The appellants further argue that the Examiner has failed to establish that claim 3 fits into any category of unpatentable subject

matter and as such is directed towards patentable subject matter. However, the Examiner does not carry to burden of classifying the type of unpatentable subject matter the appellant has claimed, but rather identifying whether the claimed invention falls within an allowable statutory class. Since the claimed invention does not fall within an allowable statutory class it is unpatentable. Additionally, it appears the applicant is unable to identify a statutory class in which he believes the invention should fall. In the Applicant remarks dated April 10, 2006, it is asserted that the invention is an article of manufacture, while in the instant Notice of Appeal the applicant argues on page 106, the applicant argues that the invention is a composition of matter.

- ***35 USC § 102 rejection of Claims 1, 2, 10-13, and 40-42***

- **Response to argument directed towards claims 1, 2, and 11**

The applicant argues that Carson does not disclose an offer pointer because the markings that appear on the billing statement do not pertain to any of the transactions. Instead, the applicant asserts that the markings concern items that are to be adjusted by mathematical calculations beginning with the “total accountability” number appearing in line 3. However, the examiner finds that offer pointer disclosed by Carson (identified as being printed on line 8 and entitled “SEE NOTE BELOW”), is an offer pointer associated with every current charge on the billing statement, and thus meets the limitation of the claims as currently written. The “total accountability” number appearing in line 3 is a summation of the individual charges and thus an association is present.

The applicant admits on Page 97, of the Appeal Brief:

“The billing statement may be a printed document, such as a credit card billing statement.”

“Therefore, the offer pointer could be, for example, a toll-free telephone number printed adjacent a description of a transaction on a credit card billing statement.”

The Carson reference discloses an offer pointer printed on a billing statement (identified as being printed on line 8 and entitled “SEE NOTE BELOW”). The offer itself, in which the pointer directed the customer attention indicates that a copy of the billing statement needs to be mailed to the biller with a copy of the check. Therefore, the customer is directed to contact the biller via postal mail and include the payment along with a copy of the billing statement in order to receive the offer. This clearly meets the limitations of claim 1 as currently written.

○ **Response to argument directed towards claim 10**

The applicant argues that Carson does not teach an offer pointer associated with a transaction and does not teach an offer pointer that comprises information for use to review an offer, so it cannot teach wherein the offer pointer is not an offer. However, as detailed in the section above entitled “Response to argument directed towards claims 1, 2, and 11, the Carson reference does teach an offer pointer that is associated with a transaction. Regarding the assertion that Carson does not teach an offer pointer that comprises information for use to review and offer, the Carson reference discloses an offer pointer identified as being printed on line 8 and entitled “SEE NOTE BELOW”. One uses the directions supplied to review the offer printed at the bottom of the page entitled “AGENT PLEASE NOTE:”. Thus the offer pointer itself is not an offer, but rather a pointer associated with the transactions and used to review the offer at the bottom of the billing statement.

○ **Response to argument directed towards claim 12**

The applicant argues that Carson does not teach an offer pointer associated with a transaction and does not teach an offer pointer that comprises information for use to review an offer, therefore it cannot teach wherein the offer pointer is associated with more than one of the plurality of transaction. As detailed in the response to arguments above entitled "Response to argument directed towards claims 1, 2, and 11, the Carson reference does teach these limitations. It is also apparent that the offer disclosed by Carson is based upon the summation of all the individual charges and as such is associated with more than one of the plurality of transaction. Line 8 of Carson indicated a 2% reduction in the total found in line 3 of Carson. Line 3 of Carson is a summation of all of the individual charges and as such is associated with each charge.

○ **Response to argument directed towards claim 13**

The applicant argues that Carson does not teach an offer pointer associated with a transaction and does not teach an offer pointer that comprises information for use to review an offer, therefore it cannot teach wherein the offer is an offer to reduce an amount owed associated with the transaction. As detailed in the response to arguments above entitled "Response to argument directed towards claims 1, 2, and 11, the Carson reference does teach these limitations. It is also apparent that Line 8 of Carson indicated a 2% reduction in the total found in line 3 of Carson. Line 3 of Carson is a summation of all of the individual charges and as such is associated with each charge. Therefore, Carson teaches reducing an amount owed that is associated with the transaction.

○ **Response to argument directed towards claim 40**

The applicant argues that Carson does not disclose an offer pointer because the markings that appear on the billing statement do not pertain to any of the transactions. Instead, the applicant asserts that the markings concern items that are to be adjusted by mathematical calculations beginning with the “total accountability” number appearing in line 3. However, the examiner finds that offer pointer disclosed by Carson (identified as being printed on line 8 and entitled “SEE NOTE BELOW”), is an offer pointer associated with every current charge on the billing statement, and thus meets the limitation of the claims as currently written. The “total accountability” number appearing in line 3 is a summation of the individual charges and thus an association is present.

The applicant admits on Page 97, of the Appeal Brief:

“The billing statement may be a printed document, such as a credit card billing statement.”

“Therefore, the offer pointer could be, for example, a toll-free telephone number printed adjacent a description of a transaction on a credit card billing statement.”

The Carson reference discloses an offer pointer printed on a billing statement (identified as being printed on line 8 and entitled “SEE NOTE BELOW”). The offer itself, in which the pointer directed the customer attention indicates that a copy of the billing statement needs to be mailed to the biller with a copy of the check. Therefore, the customer is direct to contact the biller via postal mail and include the payment along with a copy of the billing statement in order to receive the offer. This clearly meets the limitations of claim 1 as currently written.

○ **Response to argument directed towards claim 41**

The applicant argues that Carson does not disclose an offer pointer because the markings that appear on the billing statement do not pertain to any of the transactions. Instead, the applicant

asserts that the markings concern items that are to be adjusted by mathematical calculations beginning with the “total accountability” number appearing in line 3. However, the examiner finds that offer pointer disclosed by Carson (identified as being printed on line 8 and entitled “SEE NOTE BELOW”), is an offer pointer associated with every current charge on the billing statement, and thus meets the limitation of the claims as currently written. The “total accountability” number appearing in line 3 is a summation of the individual charges and thus an association is present.

The applicant admits on Page 97, of the Appeal Brief:

“The billing statement may be a printed document, such as a credit card billing statement.”

“Therefore, the offer pointer could be, for example, a toll-free telephone number printed adjacent a description of a transaction on a credit card billing statement.”

The Carson reference discloses an offer pointer printed on a billing statement (identified as being printed on line 8 and entitled “SEE NOTE BELOW”). The offer itself, in which the pointer directed the customer attention indicates that a copy of the billing statement needs to be mailed to the biller with a copy of the check. Therefore, the customer is direct to contact the biller via postal mail and include the payment along with a copy of the billing statement in order to receive the offer. This clearly meets the limitations of claim 1 as currently written.

○ **Response to argument directed towards claim 42**

The applicant argues that Carson does not disclose an offer pointer because the markings that appear on the billing statement do not pertain to any of the transactions. Instead, the applicant asserts that the markings concern items that are to be adjusted by mathematical calculations beginning with the “total accountability” number appearing in line 3. However, the examiner finds that offer pointer disclosed by Carson (identified as being printed on line 8 and entitled

“SEE NOTE BELOW”), is an offer pointer associated with every current charge on the billing statement, and thus meets the limitation of the claims as currently written. The “total accountability” number appearing in line 3 is a summation of the individual charges and thus an association is present.

The applicant admits on Page 97, of the Appeal Brief:

“The billing statement may be a printed document, such as a credit card billing statement.”

“Therefore, the offer pointer could be, for example, a toll-free telephone number printed adjacent a description of a transaction on a credit card billing statement.”

The Carson reference discloses an offer pointer printed on a billing statement (identified as being printed on line 8 and entitled “SEE NOTE BELOW”). The offer itself, in which the pointer directed the customer attention indicates that a copy of the billing statement needs to be mailed to the biller with a copy of the check. Therefore, the customer is direct to contact the biller via postal mail and include the payment along with a copy of the billing statement in order to receive the offer. This clearly meets the limitations of claim 1 as currently written.

The appellants additionally argue that there is no substantial evidence that supports the serving agent receiving the statement. However, Carson discloses that the “Total List Sales” to date is 840.99 based upon the last report. The list sales for the current month are 168.47. Therefore, the recipient of the billing statement has successfully received billing statements and sent payments during previous months.

- ***35 USC § 102 rejection of Claims 3-9, 14-19, 22, 24-29, and 32-34***

- **Response to argument directed towards claim 3**

The applicant argues that there is no support for the examiner argument that it is old and well known to present billing and other financial information as viewable electronic data. The

applicant asserts that the examiner has not provided evidence to support such an argument. However, the examiner rejections provides specific examples of such electronic viewable financial data "For example, for the past several decades customer have been able to access their financial data, to include statements, on electronic devices such as ATM machines". As such the examiner has identifies examples and provided rational to support the 35 USC 103 rejection as required by the MPEP. As such the claimed limitation would have been obvious to one of ordinary skill in the art at the time the invention was made.

○ **Response to argument directed towards claim 4**

The applicant argues that there is no evidence to support the assertion that one skilled in the art would have been motivated to update the 1960's billing statement of Carson to include more modern communication means as suggested by the examiner. However, the examiner has provided a rational that would have been obvious to one of ordinary skill at the time of the applicants invention for updating the contact method provided in the teachings of Carson. The MPEP allows for 35 USC 103 rejections based upon what is know by individuals of ordinary skill in the art. As such the examiners rational that updating the billing statement would be done in order to take advantage of the latest communication means available at the time of the invention constitutes sufficient evidence for the rejection of the claim.

○ **Response to argument directed towards claim 5**

The applicant argues that there is no evidence to support the assertion that one skilled in the art would have been motivated to update the 1960's billing statement of Carson to include more modern communication means as suggested by the examiner. However, the examiner has provided a rational that would have been obvious to one of ordinary skill at the time of the

applicant's invention for updating the contact method provided in the teachings of Carson. The MPEP allows for 35 USC 103 rejections based upon what is known by individuals of ordinary skill in the art. As such, the examiner's rationale that updating the billing statement would be done in order to take advantage of the latest communication means available at the time of the invention constitutes sufficient evidence for the rejection of the claim.

○ **Response to argument directed towards claim 6**

The applicant argues that there is no evidence to support the assertion that one skilled in the art would have been motivated to update the 1960's billing statement of Carson to include more modern communication means as suggested by the examiner. However, the examiner has provided a rationale that would have been obvious to one of ordinary skill at the time of the applicant's invention for updating the contact method provided in the teachings of Carson. The MPEP allows for 35 USC 103 rejections based upon what is known by individuals of ordinary skill in the art. As such, the examiner's rationale that updating the billing statement would be done in order to take advantage of the latest communication means available at the time of the invention constitutes sufficient evidence for the rejection of the claim.

○ **Response to argument directed towards claim 7**

The applicant argues that there is no evidence to support the assertion that one skilled in the art would have been motivated to update the 1960's billing statement of Carson to include more modern communication means as suggested by the examiner. However, the examiner has provided a rationale that would have been obvious to one of ordinary skill at the time of the applicant's invention for updating the contact method provided in the teachings of Carson. The MPEP allows for 35 USC 103 rejections based upon what is known by individuals of

ordinary skill in the art. As such the examiners rational that updating the billing statement would be done in order to take advantage of the latest communication means available at the time of the invention constitutes sufficient evidence for the rejection of the claim.

○ **Response to argument directed towards claim 8**

The applicant argues that there is no evidence to support the assertion that one skilled in the art would have been motivated to update the 1960's billing statement of Carson to include more modern communication means as suggested by the examiner. However, the examiner has provided a rational that would have been obvious to one of ordinary skill at the time of the applicants invention for updating the contact method provided in the teachings of Carson.

The MPEP allows for 35 USC 103 rejections based upon what is know by individuals of ordinary skill in the art. As such the examiners rational that updating the billing statement would be done in order to take advantage of the latest communication means available at the time of the invention constitutes sufficient evidence for the rejection of the claim.

○ **Response to argument directed towards claim 9**

The applicant argues that there is no evidence to support the assertion that one skilled in the art would have been motivated to update the 1960's billing statement of Carson to include more modern communication means as suggested by the examiner. However, the examiner has provided a rational that would have been obvious to one of ordinary skill at the time of the applicants invention for updating the contact method provided in the teachings of Carson.

The MPEP allows for 35 USC 103 rejections based upon what is know by individuals of ordinary skill in the art. As such the examiners rational that updating the billing statement

would be done in order to take advantage of the latest communication means available at the time of the invention constitutes sufficient evidence for the rejection of the claim.

○ **Response to argument directed towards claims 14-16**

The applicant argues that there is no evidence to support the assertion that one skilled in the art would have been motivated to set different terms for different offers in order to give the biller more latitude in selecting offers to present. However, the examiner has provided a rational that would have been obvious to one of ordinary skill at the time of the applicants invention for updating the types of offers provided in the teachings of Carson. The MPEP allows for 35 USC 103 rejections based upon what is know by individuals of ordinary skill in the art. As such the examiners rational that offers to extend the due date or eliminate the minimum amount due are known in the billing statement industry is sufficient evidence that the claimed limitation would have been obvious since the examine has provided a rational motivation and there are a predictable number of possible offers that can be offered by a biller.

○ **Response to argument directed towards claim 17**

The applicant argues that there is no evidence to support the assertion put forth by the examiner. However, the examiner has provided a rational that would have been obvious to one of ordinary skill at the time of the applicants invention for providing additional offers to the customer in the teachings of Carson. The MPEP allows for 35 USC 103 rejections based upon what is know by individuals of ordinary skill in the art. As such the examiners examples represent one of a predictable number of finite types of offers that are known to one of ordinary skill in the art at the time the invention was made. Additionally, the examiner has

provided a rational motivation that was well known to those of ordinary skill in the art at the time the invention was made.

○ **Response to argument directed towards claim 18**

The applicant argues that there is no evidence to support the assertion put forth by the examiner. However, the examiner has provided a rational for claim 17 that would have been obvious to one of ordinary skill at the time of the applicants invention for providing additional offers to the customer in the teachings of Carson. The MPEP allows for 35 USC 103 rejections based upon what is know by individuals of ordinary skill in the art. As such the examiners examples represent one of a predictable number of finite types of offers that are known to one of ordinary skill in the art at the time the invention was made. Additionally, the examiner has provided a rational motivation that was well known to those of ordinary skill in the art at the time the invention was made. The limitation imposed by claim 18 is that the second offer is the same as the first offer. Since the offer pointer and thus the offer in the Carson reference are based upon the sum total of the current transaction, each transaction receives a 2% discount and therefore the second offer is the same as the first offer and the limitations of the claim have been met.

○ **Response to argument directed towards claim 19**

The appellants submit that Carson cannot be said to teach or suggest the embodiment where the offer pointer is located adjacent to the description. However, a billing statement has a limited number of predictable places in which the offer pointer can be printed. While the offer pointer in Carson is adjacent to a transaction consisting of an adjustment to the total amount due, it is not next to each individual purchase transaction. Given the limited number

of possible places in which the offer pointer may be place, it would be obvious to place it next to amounts on which the adjustment can be made. Thus the sum total of all current purchase transactions would be one viable place to put the offer pointer, a separate line, as taught by Carlson, would be another viable option. The other viable option would be to place it next to the individual charges for which the discount may apply. The MPEP allows for 35 USC 103 rejections based upon what is know by an individual of ordinary skill in the art. As such the examiners examples represent one of a predictable number of finite types of placement that are known to those of ordinary skill in the art at the time the invention was made.

(11) Related Proceeding(s) Appendix

- No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

• This examiner's answer contains a new ground of rejection set forth in section (9) above.

Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in

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37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

John Van Bramer /J.V.B./
Examiner, Art Unit 3622

Eric Stamber/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622

Conferees:

Eric Stamber/E. W. S./
Supervisory Patent Examiner, Art Unit 3622

Vincent Millin /VM/
Appeals practice Specialist



A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR